

REMARKS

Claims 1-20 and 23-57 are pending in the application.

Claims 52-57 have been amended herein to state that the oligonucleotide is complementary to nucleic acid sequence GCCAGTGAGGAGGCACGC (SEQ ID NO:11) encoding N-terminal codons 8-13 of protein kinase A subunit RI α . This amendment was made to clarify the specific codons to which the claim is referring and to state the sequence to which the claimed oligonucleotide is complementary. As discussed in more detail below, support for this amendment is found in the specification at, *inter alia*, Table 1, page 22. Accordingly, no new matter has been introduced by this amendment. This amendment is made without prejudice to prosecuting claims of broader scope in continuation or divisional applications.

The specification has been amended to correct formalities in the cross-reference to related applications section and to indicate that one of the priority applications (09/022,965, filed on February 12, 1998) also claims the benefit of U.S. Provisional Application No. 60/040,740, filed March 12, 1997. 37 C.F.R. § 1.78(a)(2)(ii)(B) states that the time periods in the recited paragraph do not apply if the later-filed application is “[a]n application filed under 35 U.S.C. § 111(a) before November 29, 2000.” Although a CPA (with the same serial number) was filed in this case, the original application was filed October 5, 1999. Accordingly, Applicant respectfully submits that this amendment to the priority claim is proper.

The specification has also been amended to provide a new sequence listing to incorporate SEQ ID NO:11 described above. For the reasons above and described in more detail below, no new matter has been introduced by this amendment.

The remaining outstanding rejections are addressed below.

Claims 1-20 and 23-57 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

The Office Action states at page 3, that the sequence of the oligonucleotides according to SEQ ID NOS: 1, 4, and 6 cannot be used to predict the structures of the full scope of oligonucleotides encompassed by the instant claims, or the structure of the full scope of nucleic acid sequences encoding the N-terminal 8-13 codons of protein kinase A subunit RI α encompassed by the instant claims. The Office Action further states that the instant claims encompass oligonucleotides targeting all polymorphic, allelic, and splice variants of nucleic acid encoding the N-terminal 8-13 codons of protein kinase A subunit RI α , including all nucleic acid species variants of protein kinase A isolated from all sources. Finally, the Office Action states at page 4 that since further experimentation is required to determine the structures of those compounds and targets that are encompassed by the instant claims, Applicant was not in possession of the full scope of compounds encompassed by the instant claims at the time of filing.

Although Applicant disagrees with this rejection, in order to expedite prosecution, claims 52-57 have been amended to recite that the claimed embodiments of the oligonucleotide in the various claimed embodiments of the invention are complementary to nucleic acid sequence GCCAGTGAGGAGGCACGC (SEQ ID NO:11) encoding N-terminal codons 8-13 of protein kinase A subunit RI α .

Applicant submits that this amendment does not introduce new matter. As indicated in the specification at page 21, lines 22-23, the sequence of this gene was known. In addition, numerous references relating to protein kinase A subunit RI α are cited in the specification at, *inter alia*, page 3, line 14 to page 4, line 9. Furthermore, the sequence recited in the claims is inherent from SEQ ID NOS: 1, 4, and 6 as identified in Table 1 at page 22 of the specification.

According to M.P.E.P. 2163(I)

[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

As stated in M.P.E.P. 2163(I)(B)

[w]hile there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.

This concept is additionally described in M.P.E.P. 2163.02, which states that

[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.

Furthermore, as described in M.P.E.P. 2163(II)(3)(a)

[w]hat is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. . . . If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. (citations omitted)

As described above, the sequence of this gene was known to those with ordinary skill in the art, numerous references relating to protein kinase A subunit RI α are cited in the specification, and the sequence recited in the claim is inherent from SEQ ID NOS: 1, 4, and 6 as identified in Table 1. Accordingly, Applicant submits that there is adequate written description for this limitation and that this limitation does not disclose new matter.

Accordingly, in view of this amendment, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

CONCLUSIONS

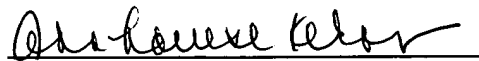
In view of the arguments set forth above, Applicant respectfully submits that the rejections contained in the Office Action mailed on May 18, 2004, have been overcome, and that the claims are in condition for allowance. If the Examiner believes that any further discussion of this communication would be helpful, she is invited to contact the undersigned at the telephone number provided below.

Applicant encloses herewith a Petition for a Two Month Extension of Time pursuant to 37 C.F.R. § 1.136, until October 20, 2004, to respond to the Examiner's Office Action mailed on May 18, 2004. Please charge our Deposit Account No. 08-0219 the \$210.00 fee for this purpose.

Applicant also encloses herewith a Supplemental Information Disclosure Statement. Please charge our Deposit Account No. 08-0219 the \$180.00 fee for this purpose.

No other fees are believed to be due in connection with this response. However, please charge any underpayments or credit any overpayments to Deposit Account No. 08-0219.

Respectfully submitted,



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